

Customer No. 27061
Confirmation No. 9840

Patent
Attorney Docket No. GEMS8081.208

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Shillinglaw et al.
Serial No. : 10/749,452
Filed : December 31, 2003
For : Method and System for Dynamically Analyzing Consumer Feedback
to Determine Project Performance
Group Art No. : 3628
Examiner : Igor N. Borissov

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

I hereby certify that, on the date shown below, this correspondence is being:

Mailing

deposited with the US Postal Service in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

37 CFR 1.8(a) 37 CFR 1.10

with sufficient postage as first class mail As "Express Mail Post Office to Addressee" Mailing Label No.

Transmission

transmitted by facsimile to Fax No.: 571-273-8300 addressed to Examiner Igor N. Borissov at the Patent and Trademark Office.
 transmitted by EFS-WEB addressed to Examiner Igor N. Borissov at the Patent and Trademark Office.

Date: July 5, 2007

/Robyn L. Templin/
Signature

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF CONFERENCE REQUEST

Dear Sir:

Applicant hereby requests pre-appeal review of the final rejection in the above-identified Application. The request is being filed with a Notice of Appeal. Review is requested for the reasons set forth hereinafter:

REMARKS

Claims 24-43 are pending in the present application. In the Final Office Action mailed April 4, 2007, the Examiner rejected claims 39-43 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The Examiner next rejected claims 24-35 and 37-43 under 35 U.S.C. §103(a) as being unpatentable over Oyagi et al. (USP 6,199,193). Claim 36 was rejected under 35 U.S.C. §103(a) as being unpatentable over Oyagi et al., in view of Eringis et al. (US Pub. 2003/0202638).

Applicant believes the Panel has the authority to overturn these rejections because this request relies on the fact that, through procedural errors, the Examiner has not satisfied the burden to establish a *prima facie* case of unpatentability or obviousness in the rejections of claims 24-43 under 35 U.S.C. §101 and 35 U.S.C. §103(a) and has failed to properly examine and consider all elements of the pending claims.

Rejection under 35 U.S.C. §101

With regard to the rejection of claims 39-43 under 35 U.S.C. §101, the Examiner stated that “claim 39 is directed to non-statutory subject matter because a ‘signal’ is not considered statutory.” *Final Office Action*, April 4, 2007, p. 2. The Examiner further asserted that “[a] carrier wave is not a process, machine, manufacture, or composition of matter” and that “[t]herefore, the claim is directed to non-statutory subject matter and is not considered statutory.” *Id.* at 6. The Examiner, however, did not cite any evidence or support for this position. The MPEP fails to state that a claim directed to a signal is not statutory or not eligible for patent rights. Rather, MPEP §2106 states that “[t]he subject matter courts have found to be outside of, or exceptions to, the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena.” Clearly, a computer data signal embodied in a carrier wave, as called for in claim 39, is not an abstract idea, law of nature, or natural phenomenon. MPEP §2106 further states that “[t]he burden is on the USPTO to set forth a *prima facie* case of unpatentability.” The Examiner has not satisfied this burden. The acts called for in claim 39 are directed to a computer data signal that represents a sequence of instructions that, when executed by one or more computers, cause the one or more computers to perform produce a useful, concrete and tangible result. As such, Applicant believes that claims 39-43 are directed to statutory subject matter. Accordingly, Applicant requests withdrawal of the rejection of claims 39-43 under 35 U.S.C. §101.

Rejection under 35 U.S.C. §103(a)

The Examiner rejected claims 24-35 and 37-43 under 35 U.S.C. §103(a) as being unpatentable over Oyagi. The Examiner stated that Oyagi “does not explicitly teach that said users include *users of a newly integrated business unit*” and “does not explicitly teach that said business plan *integrates the newly integrated business unit within a business enterprise.*” *Office Action*, supra at 3-4. Applicant agrees.

The Examiner then stated that “[h]owever, the fact that whether said users include *users of a newly integrated business unit*, or not, cannot affect the method steps recited.” *Id.* The Examiner also stated that “[h]owever, the fact that whether said business plan *integrates the newly integrated business unit within a business enterprise*, or not, cannot affect the method steps recited.” *Id.* The Examiner asserted that “information as to that said users include *users of a newly integrated business unit* is non-functional language and given no patentable weight” and that “information as to that said business plan *integrates the newly integrates [sic] business unit within a business enterprise*, and that the business plan is *an implemented* business plan, is non-functional language and given no patentable weight.” *Id.* Applicant respectfully disagrees that such information is non-functional language.

The Examiner cited MPEP §2106(II)(C), which states that “[l]anguage that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.” *See Office Action*, supra at 4. However, claim 24, for example, does not call for providing a feedback inputting graphical user interface optionally to users of a newly integrated business unit. Claim 24 also does not call for receiving a plurality of user feedback from individuals associated with the newly integrated business unit on a business plan, optionally implemented, that optionally integrates the newly integrated business unit within a business enterprise. Instead, such limitations are not optional and must be given patentable weight.

Furthermore, MPEP §2106.01 states that “[n]onfunctional descriptive material’ includes but is not limited to music, literary works, and a compilation or mere arrangement of data.” The subject matter identified by the Examiner in claims 24-35 and 37-43 as allegedly being non-functional language does not fit that described by the MPEP as being nonfunctional descriptive material. While the nonfunctional descriptive material listed in the MPEP is not limited to that material listed, Applicant believes that the Examiner has not satisfied the burden to show that the subject matter of claims 24-35 and 37-43 contains no nonfunctional descriptive material.

In addition to failing to give patentable weight to all the elements of the pending claims, the Examiner has also failed to establish a *prima facie* case of obviousness in rejecting claims 24-35 and 37-43 under §103.

First, a *prima facie* case of obviousness requires “some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” MPEP §2413. While the Examiner asserted that “it would have been an obvious matter of design choice to modify Oyagi et al. to include that user’s responses include neutral responses and too-early-to-tell responses...,” such assertion of a motivation at best only applies to claims 25, 32, and 43, which include the subject matter of one or both of a neutral response and a too-early-to-tell response. The Examiner made no such assertion of a motivation with regard to claims 24, 26-31, 33-35, and 37-42. As such, with regard to a claims 24, 26-31, 33-35, and 37-42, a *prima facie* case of obviousness has not been met by the Examiner.

Second, with regard to claims 25, 32, and 43, the Examiner stated that Oyagi “does not explicitly teach that said received responses include neutral responses and too-early-to-tell responses, and that the business plan is an implemented business plan.” *Office Action*, supra at 4. The Examiner then stated that “[h]owever, based on common sense, it is within [sic] ability of one having ordinary skill in the art to come up with variations of possible feedbacks.” *Id.*

The Examiner’s reliance on “common sense” is improper. MPEP §2144.03 states:

It is never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 (“[T]he Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”).

Neither the Board nor the Examiner may rely on common sense without pointing to some concrete evidence in the record to support a finding. In this case, the Examiner has not pointed to any concrete evidence in the record to support the Examiner’s finding. Accordingly, the Examiner’s reliance on common knowledge is improper. As such, with regard to claims 25, 32, and 43, a *prima facie* case of obviousness has not been met by the Examiner.

With regard to claims 37 and 38, the Examiner asserted that Oyagi fails to “specifically teach that said personal information includes a name, and address, a telephone, number, a county,

a zip code, a region, and email address and a sales representation name.” *Office Action*, supra at 5. The Examiner then asserted that “based on common sense, it is within [sic] ability of one having ordinary skill in the art to come up with variations of personal information.” *Id.* As with the rejection of claims 25, 32, and 43, the Examiner has not pointed to any concrete evidence in the record to support the Examiner’s finding. Accordingly, the Examiner’s reliance on common knowledge is improper. As such, with regard to claims 37 and 38, a *prima facie* case of obviousness has not been met by the Examiner.

Accordingly, that which is called for in claims 24-35 and 37-43 is not shown, disclosed, taught, or suggested in the art of record. As such, Applicant believes claim 24-35 and 37-43, and the claims which depend therefrom, are patentably distinct from the art of record.

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 24-43.

A fee in the amount of \$500.00 is being paid via EFS-Web for fees associated with the Notice of Appeal being filed concurrently herewith.

Applicant appreciates the Panel’s consideration of these Amendments and Remarks.

Respectfully submitted,

/Kevin R. Rosin/

Kevin R. Rosin
Registration No. 55,584
Phone 262-268-8100 ext. 15
krr@zpspatents.com

Respectfully submitted,

/Kent L. Baker/

Kent L. Baker
Registration No. 52,584
Phone 262-268-8100 ext. 12
klb@zpspatents.com

Dated: July 5, 2007
Attorney Docket No.: GEMS8081.208

P.O. ADDRESS:

Ziolkowski Patent Solutions Group, SC
136 South Wisconsin Street
Port Washington, WI 53074
262-268-8100